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VJ
Paper Number 13/14

In re application of :
Kenichi NAKAMA et al. : **DECISION ON**
Serial No.: 09/529,990 : **PETITION**
Filed: April 24, 2000 :
For: MULTILAYER-COATED SUBSTRATE :
AND PROCESS FOR PRODUCING :
THE SAME :

This is a decision on the petition under 37 CFR 1.144 filed August 19, 2002 (Paper No. 12) to request a review and a withdrawal of a two-way restriction requirement set forth in the Office Action mailed February 7, 2002 (Paper No. 6).

DECISION

Since the present application was filed on the national stage under 35 USC 371, the propriety of a restriction requirement or "unity of invention" is evaluated by the criterion stated in PCT Rule 13 (or, alternatively, in 37 CFR 1.475(a)), namely, unity of invention exists between multiple inventions only when these inventions share one or more "special technical features" in common with the understanding that these special technical features define a contribution which each of the inventions makes over the prior art.

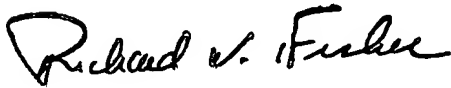
Applicants' principal argument is that 37 CFR 1.475(b) "expressly provides" that a product and a process specially adapted for the manufacture of said product will be considered as having unity of invention. This argument is unpersuasive in view of the preceding subsection of the cited rule, namely, 37 CFR 1.475(a) which, as stated above, requires that any technical features shared between the product and process must define a contribution over the prior art. It would defeat the purpose of the rule if solace could be sought in subsection (b) when the criterion of subsection (a) of 37 CFR 1.475 is not fulfilled.

A proper analysis for unity of invention begins with an identification of such shared technical features. Although, unfortunately, the examiner did not indicate what the special technical features were (cf. the restriction requirement in Paper No. 6) and compounded the problem by asserting that the technical feature present in Group I "is not found in Group II" (cf. examiner's response to applicants' traverse in paragraph 1 of the Office Action mailed April 18, 2002 in Paper No. 8), nevertheless, a perusal of the claims reveals that there is indeed a technical feature that is shared in common between the two Groups, namely, a multilayered object involving superposed layers

comprising organopolysiloxane on a substrate. Keeping that in mind, we turn to Andrus (US 5,212,596) cited by the examiner as disclosing such a multilayered object (cf. paragraph 1 in Paper No. 6). Particular attention is drawn to col. 2, lines 27-31 of Andrus which discloses a layered article comprising a viewing portion and a contiguously situated substrate portion, and, to col. 5, lines 7-8 which divulges that silicone (recognized in the synthetic resin art as an alternative name for polyorganosiloxane which applicants refer to as organopolysiloxane) is one of the preferred materials for the viewing portion. In light of Andrus, it is evident that the shared technical feature that links the claims of Groups I and II does not define a contribution over the cited prior art. Hence, the shared technical feature is not a "special technical feature" as defined by the criterion given in 37 CFR 1.475(a), or PCT Rule 13. Accordingly, Groups I and II lack unity of invention.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the restriction requirement is proper.

The petition is **DENIED**.



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